

REMARKS

Favorable reconsideration of this application as presently amended, and in light of the following discussion, is respectfully requested.

Claims 2-26 are pending in this case. Claim 1 has been canceled without prejudice or disclaimer. Claims 25 and 26 are new. Claims 2-8 have been amended by the present amendment. Support for amended Claims 2-8 and new Claims 25 and 26 can be found in the original specification, claims, and drawings.¹ No new matter is presented.

In the outstanding Office Action, the specification and claims were objected to because of informalities; Claim 8 was rejected under 35 U.S.C. § 112, second paragraph; Claims 1-4 and 7-8 were rejected under 35 U.S.C. § 102(b) as anticipated by Kontos (U.S. Patent No. 5,855,585); and Claims 5-6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kontos in view of Kortenbach et al. (U.S. Patent No. 6,096,051, hereinafter “Kortenbach”).

As an initial matter, Applicants respectfully submit that this case properly claims priority to JP 2002-124829, JP 2002-133940, and JP 2002-155865. This application is a 371 of PCT/JP03/05406 which was filed on April 25, 2003. This application was filed on October 25, 2004 which was within 30 months of the filing of JP 2002-124829, JP 2002-133940, and JP 2002-155865, which were filed on April 25, 2002, May 9, 2002, and May 29, 2002, respectively.

In response to the objection to the specification, Applicants respectfully submit that the Preliminary Amendment filed on October 25, 2004 contained an Abstract. Accordingly, Applicants respectfully request the objections be withdrawn.

¹ See the specification at page 18, lines 6-15; page 24, lines 12 to page 25, line 14; and Figs. 1-17.

In response to the objections to the claims, Applicants have amended Claims 3-8 in accordance with the suggestions set forth in the outstanding Office Action. Accordingly, Applicants respectfully request the objection be withdrawn.

In response to the rejection of Claim 8 under 35 U.S.C. § 112, second paragraph, Applicants have amended the words “said opening” to recite “an opening.” Accordingly, Applicants respectfully request the rejection be withdrawn.

In response to the rejection of Claims 1-4 and 7-8 under 35 U.S.C. § 102(b) as anticipated by Kontos, Applicants respectfully submit that amended independent Claim 2 recites novel features clearly not taught or rendered obvious by the applied references.

Claim 2 is directed to an organism tissue suturing apparatus for suturing a penetrated hole formed subcutaneously in a tissue membrane of an organism, wherein,

... said rotary portion has two needle member receiving portions for receiving a distal end of one of said hollow needle members and that of the other of said hollow needle members respectively pressed out of said body part; and ***a connection duct communicating with said two needle member receiving portions;*** and

a duct for a suturing thread is formed in a range from one of said two openings to the other of said openings through an inside of one of said two hollow needle members, ***said connection duct, and an inside of the other of said two hollow needle members***, when said two needle member receiving portions receive said hollow needle members respectively at a same time.

Turning now to the applied reference, Kontos describes a device for suturing blood vessels. However, Kontos fails to teach or suggest “***a connection duct communicating*** with said two needle member receiving portions,” as in Applicants’ amended independent Claim 2. Page 5 of the outstanding Office Action asserts that opening 33 is a “connection duct” and needle retention bores 32 and 32’ are “needle receiving portions.” However, opening 33 as seen in Figure 1 of Kontos is not enclosed and thus is not a duct. In Kontos, as shown in

Figure 6B, needle retention bores 32 and 32' extend from distal ends to openings 33 and 33', respectively, formed at a position in the distal end of a central arcuate portion 22 opposite an opening 10.² Thus, in Kontos the opening 10 forms an air gap between openings 33 and 33'. In contrast, in Applicants' independent Claim 2, there is "**a connection duct** communicating with said two needle member receiving portions."

Further, Kontos fails to teach or suggest that "**a duct for a suturing thread is formed** in a range from one of said two openings to the other of said openings through an inside of one of said two hollow needle members, **said connection duct, and an inside of the other of said two hollow needle members**, when said two needle member receiving portions receive said hollow needle members respectively at a same time," as in Applicants' independent Claim 2. As stated above there is not a duct formed but rather an airgap between openings 33 and 33'. In contrast, Claim 2 recites "a duct for suturing thread is formed in a range from one of said two openings to the other of said openings through an inside of one of said two hollow needle members, **said connection duct, and an inside of the other of said two hollow needle members.**"

Thus, Applicants respectfully submit that Kontos fails to teach or suggest each and every element of Applicants' amended independent Claim 2. Claims 3-8 depend on Claim 2 and are thus believed to be patentable for at least the reasons discussed above.

Accordingly Applicants' respectfully request the rejection of Claims 1-4 and 7-8 under 35 U.S.C. § 102(b) as anticipated by Kontos, be withdrawn.

In response to the rejection of Claims 5-6 under 35 U.S.C. § 103(a) as unpatentable over Kontos in view of Kortenbach, it is noted that Claims 5-6 are dependent from Claim 2, and thus are believed to be patentable for at least the reasons discussed above. Further it is

² See Kontos at column 4, lines 61-64.

respectfully submitted that Kortenbach fails to cure any of the above-noted deficiencies of Kontos.

Accordingly, Applicants respectfully request the rejection of Claims 5-6 under 35 U.S.C. § 103(a) as unpatentable over Kontos in view of Kortenbach, be withdrawn.

New Claims 25 and 26 are supported by page 23, lines 17-18 and page 24, lines 12 to page 25, line 14 of the specification; and Figs. 1-17. New independent Claim 25 is directed to a method for suturing a penetrated hole formed in a blood vessel including, *inter alia*, the step of “passing a suturing thread from a proximal end of the first hollow needle member through the first needle member receiving portion, *a duct in the rotary portion*, the second needle member receiving portion, and the second hollow needle member, to a proximal end of the second hollow needle member.”

As mentioned above with respect to the rejection of Claim 2, neither Kontos nor Kortenbach teach or suggest a duct in the rotary portion connecting the first and second needle members. New Claim 26 is dependent from Claim 25 and is believed to be patentable for the reasons discussed above.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Edward Tracy
Richard D. Kelly
Attorney of Record
Registration No. 27,757

Andrew T. Harry
Registration No. 56,959

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)
RDK/ATH:sjh
I:\ATTY\DPB\2636 TERUMO\260364US-AM.DOC

Edward W. Tracy
Registration No. 47,998